

REMARKS

Status of the claims

Claims 1-14, 16-19 are pending.

Claims 1-14, 16-19 have been rejected for double patenting.

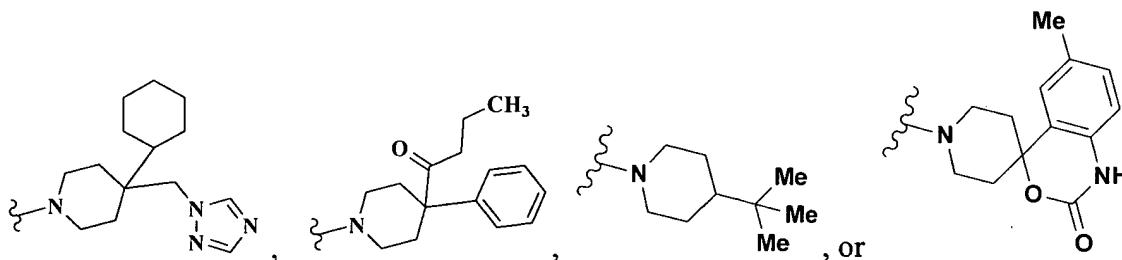
Claims 1-14 and 16-19 are rejected under 35 U.S.C. 103(a)

Restriction Requirement

The Office Action states that the claims of this application recites at least two separate classes of invention. The Office Action requests that the applicant elect one of these for prosecution as well as a single species, falling in the elected group. With one exception, Applicants confirm the provisional election made by telephone on December 22, 2004 of Group I, reading on claims 1-14, 16-19 drawn to compounds and pharmaceutical compositions of formula I. The species of claim 18 were discussed in the telephone conversation of December 22, 2004.

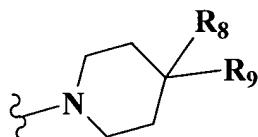
Applicants understood that this was a provisional election for purposes of search and examination only, in accordance with MPEP § 803.02, and not a requirement to restrict the scope of the generic and subgeneric claims of this application to such species. Applicants understood that, if the elected species is found to be allowable, applicant's claims covering other disclosed species will be considered and examined, since applicant is entitled to consideration to claims to a reasonable number of species in addition to the elected species as provided for under 37 CFR 1.146. Applicant reserves the right to present claims to any non-elected inventions in one or more divisional applications.

The election requirement is traversed for the following reason. The Examiner proposes to restrict Group I to compounds and pharmaceutical compositions of formula I wherein W is azetidinyl or imidazolyl, both of which are optionally substituted with lower alkyl, and G is chosen from $-\text{NR}_{18}\text{C}(=\text{O})\text{R}_{19}$, $-\text{NR}_{18}\text{SO}_2\text{R}_{17}$, $-\text{NR}_{18}\text{CO}_2\text{R}_{19}$, and $-\text{NR}_{20}\text{C}(=\text{O})\text{NR}_{18}\text{R}_{19}$. Further, the Examiner proposes that the E group be severely limited to the exact three specific groups of claim 9 as set out below:



Applicants traverse this restriction for two reasons.

1. Restriction of the invention down compounds where W is azetidinyl or imidazolyl is severe, but Applicants believe it is unreasonable for the Examiner to further require that such groups are **only** substituted by lower alkyl groups.
2. Applicants believe that narrowing E down to three **particularly** substituted E groups is unreasonable and request that E be searched on to the extent it is represented in the structure of claim 5, with limited definitions of R₈ and R₉ chosen from claim 8. Accordingly, E would be defined as follows:



where R₈ and R₉ are selected independently from hydrogen, alkyl, -(CH₂)_j-C(=O)alkyl, -(CH₂)_j-phenyl, -(CH₂)_j-naphthyl, -(CH₂)_j-C₄₋₇cycloalkyl, -(CH₂)_j-heterocyclo, and -(CH₂)_j- heteroaryl, **provided R₈ and R₉ are not both hydrogen**, or R₈ and R₉ together form a spirocycloalkyl or spiroheterocyclic ring; and j is selected from 0, 1, 2 and 3.

Claims 1-14, and 16-19 have been amended to suit the restriction to Group I with the above exceptions. No new matter has been added by these amendments, nor has the scope of the claims been broadened thereby.

Applicants thus traverse the restriction requirement and request that a search and examination be performed with regard to all claims now pending. A search directed to the compounds covered by the pending claims can be performed, without serious burden. It would conflict with Markush practice and applicants' right to present a genus claim under 37 CFR § 1.141 if restriction were further required as to the genus defined by the present claims.

Rejection for Double Patenting

The Examiner has rejected claims 1-14 and 16-19 under the judicially created doctrine of obviousness-type double patenting over claims 1-13 and 15 of U.S. Patent No. 6,713,487. In response Applicants have submitted a terminal disclaimer that accompanies this amendment.

Rejection under 35 U.S.C. 103(a)

The Examiner has rejected claims 1-14, and 16-19 under 35 U.S.C. 103(a) as being unpatentable over U.S. 5804578 ("Chakravarty) contending that Chakravarty describes compounds

similar to the present invention and that these compounds are "also used as growth hormones".
Applicants respectfully traverse.

In addition to the different substitution on the piperidine ring already noted by the Examiner, the Chakravarty compounds are different in other aspects from Applicants' compounds.

Chakravarty describes compounds in which W is an imidazolyl ring, y is 1, G is $-NR_{18}C(=O)R_{19}$, and R_{19} is $-C(H)(Me)(NH_2)$. However, Applicants' compounds do not include compounds where R_{19} is $-C(H)(Me)(NH_2)$. For the Examiner's convenience the relevant portion of the proviso at the end of the definition of R_{18} is reproduced below:

... provided, however, that when y is at least one, W is imidazolyl, ... and G is $-NR_{18}C(=O)R_{19}$, then R_{19} is not a C_1 -alkyl having the substituent $-NR_{29}R_{31}$

Moreover, one of skill in the art would not attempt to design modulators of melanocortin receptors based on growth hormone promoters as the mechanism of action is quite different. Modulators of melanocortin receptors are not known to have use as growth hormone promoters. For at least the reasons above, Applicants believe their invention is not obvious over the compounds described in Chakravarty and respectfully request withdrawal of the rejection under 35 U.S.C. 103(a).

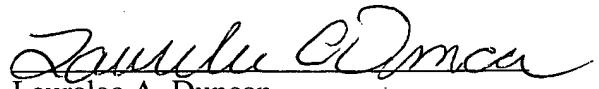
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Aside from the fee for terminal disclaimer, no additional fees should be due. However, if it is determined that a fee is due, please charge same to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

SUMMARY

Applicants believe the claims are now in condition for allowance and request issuance of the above-referenced application. The Examiner is invited to contact the undersigned by telephone, at the number listed below, if it is believed that a telephonic communication would facilitate the prosecution of this application.

Respectfully submitted,


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